

throughout the application as filed. A marked-up version of the claim as amended can be found in Appendix A. Upon entry of the amendment, claims 18-30 will be pending in the application.

### **Response**

Claims 18-30 were rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Tanaka et al. (U.S. Patent No. 5,879,813) in view of Carespodì et al. (U.S. Patent No. 5,342,684). The rejection, to the extent applied against the claims as amended, is respectfully traversed.

Initially, Applicant points out the present invention is directed toward a film comprising at least one layer of amorphous or semi-crystalline polyester obtained from the condensation of a diacid component comprising terephthalic acid with ethylene glycol and a diol component comprising at least three carbon atoms, and at least one layer of polyolefin, and further comprising a plane of symmetry which is parallel to the film, said symmetry applying both to the geometry and to the composition of the film, the film being for wrapping objects and being capable of substantially retaining its shape.

The Office Action alleges that "Tanaka et al. discloses a three layer film comprising a first polymer layer which is a polyolefin such as polyethylene and a second polymer layer on both sides of the first layer, said second polymer layers comprises, wherein the polyester is principally derived from terephthalic acid and ethylene glycol, with up to 10 mol% of a comonomer such as 1,4-cyclohexanedimethanol." (citations omitted). The Office Action further alleges that "the multilayer film has a typical total thickness of 5-100 microns," can be metallized, and may contain a lubricant or release agent. The Office Action cites Carespodì et al. as allegedly disclosing "that it is well known in the art to form laminate structures symmetrical in structure and composition in order to prevent undesirable curling during subsequent manufacturing operations." Finally, the Office Action alleges that it would have been obvious "to make the multilayer film of Tanaka et al. symmetrical in structure and composition in order to avoid undesirable curling during additional processing" and one "would have selected the crystallinity (or lack thereof) as indicated in claim 19, of the polyester depending on the specific mechanical, optical, or other physical properties desired in a specific application."

Applicant notes and thanks the Examiner for acknowledging that Tanaka et al. fails to disclose the recited symmetry found in the claims.

Applicant contends that Tanaka et al. does not disclose, teach or suggest a film for

wrapping objects comprising an amorphous or semi-crystalline polyester. Tanaka et al. teaches the opposite: that lower crystallinity results in deterioration of heat resistance, dimensional stability and mechanical properties of the resulting film. (Col. 7, lines 17-22). In fact, a film of high crystallinity would be unsuitable for use as a film for wrapping objects and which is capable of substantially retaining its shape.

Applicant further contends that one of ordinary skill in the art would not look to the films of Tanaka et al. for the design of wrapping films in the first instance. Tanaka et al. does not exclude any types of polyesters and those polyesters which are suggested are inapposite. Tanaka et al. is directed to an invention with an entirely different purpose from that of Applicant: production of thin films capable of peeling apart to produce a thin film of a polymer for applications such as capacitors. Accordingly, even if, per chance, one interested in films for wrapping objects were to look to Tanaka et al., Tanaka et al. provides no suggestion that any of the polyesters is capable of substantially retaining its shape.

Applicant respectfully disagrees that one of skill in the art would be motivated to modify the crystallinity of Tanaka et al.'s film to achieve desired properties. "The mere fact that a device or process utilizes a known scientific principle does not alone make that device or process obvious." *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q.2d 1434, 1440 (Fed. Cir. 1988). The Examiner's assertion is based on the faulty premise that an artisan consulting Tanaka et al. would first recognize any of the films as suitable, by modification, for use in an entirely different application not remotely disclosed or suggested by Tanaka et al. A disclosure directed to a multi-layer, highly crystalline film with good peeling properties for the separation of film layers into thin films for use such as in capacitors does not teach, disclose, or suggest an amorphous or semi-crystalline film for wrapping objects and which is substantially capable of retaining its shape.

Further, low adhesion between the polymer layers is required for good peeling of the layers in Tanaka et al.'s film. (Col. 8. lines 12-24). This adhesion can be further lowered by the use of lubricants to aid the peeling. (Col. 8, lines 31-34). Low adhesion between polymer layers is not present, nor desired, in Applicant's invention. This higher adhesion is believed to result primarily from the largely amorphous nature of the polyester.

In short the film of Tanaka et al. has high crystallinity and low adherence between layers, both of which make it unsuitable for the purpose of the claimed invention.

Carespodi et al. is likewise inapposite as a reference in the instant case. Carespodi et al. is directed to lid materials which do not curl during heat packaging. (Col. 5, lines 29-35). One skilled in the art would not look to films designed for heat packaging when designing a film for the purpose of the present invention. In fact, a stated advantage of the Applicant's invention is the absence of a need for heat sealing the film after wrapping an object, as discussed in the application at pages 4 and 5. Further, one would not be motivated to combine the teachings of a reference for peelable films with heat sealing lid films.

Even if such motivation to combine existed, which it does not, one would still not be motivated to use the peelable films of Tanaka et al. and the heat packaging films of Carespodi et al. to particularly manufacture Applicant's film for wrapping objects. The statutory standard of §103 is whether the invention, considered as a whole, would have been obvious to one of ordinary skill in the art, not whether it would have been obvious for one of ordinary skill in the art to try various combinations. *Akzo N.V. v. E.I. duPont de Nemours*, 1 U.S.P.Q.2d 1704, 1707 (Fed. Cir. 1987). The rejection is respectfully traversed.

Since claim 18, from which claims 19-30 depend, is both novel and non-obvious, over Tanaka et al. in view of Carespodi et al., the combination would not have rendered obvious to one of ordinary skill in the art the film for wrapping objects defined by those dependent claims. The rejection is respectfully traversed.

### CONCLUSION

Applicant asserts that the above-referenced application is in condition for allowance. Reconsideration and allowance of all pending claims is respectfully requested. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at 202-955-1928.

Respectfully submitted,

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The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-0206.



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**APPENDIX A**

**Marked-up Version of Amended Claims**

18. A film comprising [multiple layers,] at least one layer [comprising at least one] of amorphous or semi-crystalline polyester obtained from the condensation of a diacid component comprising terephthalic acid with ethylene glycol and a diol component comprising at least three carbon atoms, and at least one layer of polyolefin, and further comprising a plane of symmetry which is parallel to [it] said film, said symmetry applying both to the geometry and to the composition of [the] said film, said film being for wrapping objects and being capable of substantially retaining its shape.

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